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10/057,811	01/25/2002	John Hulls	033357-007	5459

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EXAMINER

HORTON, YVONNE MICHELE

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
10/057,811

Applicant(s)  
JOHN HULLS ET AL.

Examiner  
YVONNE M. HORTON

Art Unit  
3635



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 25, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9-12, 17-20, 25-27, and 29-36 is/are rejected.
- 7) ☒ Claim(s) 5-8, 13-16, 21-24, and 28 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jan 25, 2002 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 6) ☐ Other:

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## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 and 2 are rejected under the judicially created doctrine of double patenting over claims 1 and 4 of U. S. Patent No. 6,374,551; respectively, since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

A structural reinforcing system including a frame having a vertical section, a channel/track, movable panels with groove engagement/track engaging devices, and a restraining device to restrain the movable panel under shear stresses.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

### ***Claim Objections***

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 33-35 have been renumbered as claims 34-36.

### ***Claim Rejections - 35 USC § 102***

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

a person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent

#5,657,805 to MAGRO. MAGRO discloses the use of a structural reinforcement system for reinforcing an opening (12) in a wall (14) of a building including a frame (16) having two vertically spaced members (22,24) and at least one horizontal member (20) connected thereto; at least one channel member (32) connected to the vertical frame members (22,24) wherein the perpendicular legs of the L-shape of the channel member (32) forms a groove for slidably receiving at least one groove engagement device (48) disposed at the ends of at least one panel member (28) that forms the movable panel member (26) positioned in the opening (12); and at least one panel restraining device (46) wherein the movable panels (26) and channels (40) are in communication such that the movable panel (26) provides a continuous load path when placed in a shear force transmitting position, column 2, lines 34-36 and column 5, lines 5-22. Regarding claim 2, the system of MAGRO also includes an interlocking means (L) for releasably securing the movable panels (26). In reference to claim 3, there is a second restraining device (46) disposed at and opposite end of the movable panels (26). Regarding claim 4, MAGRO, column 2, lines 4-7, indicates that his system can be automated.

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6. Claims 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #5,657,805 to MAGRO. MAGRO discloses the use of a structural reinforcement system for reinforcing an opening (12) in a wall (14) of a building including a frame (16) having two vertically spaced members (22,24) and at least one horizontal member (20) connected thereto; at least one channel member (32) connected to the vertical frame members (22,24) and a second channel member (34) coupled to the first channel member (32) to form a groove (40) therebetween for slidably receiving at least one groove engagement device (48) disposed at the ends of at least one panel member (28) that forms the movable panel member (26) positioned in the opening (12); and at least one panel restraining device (46) wherein the movable panels (26) and channels (40) are in communication such that the movable panel (26) provides a continuous load path when placed in a shear force transmitting position, column 2, lines 34-36 and column 5, lines 5-22. Regarding claim 10, the system of MAGRO also includes an interlocking means (L) for releasably securing the movable panels (26). In reference to claim 11, there is a second restraining device (46) disposed at and opposite end of the movable panels (26). Regarding claim 12, MAGRO, column 2, lines 4-7, indicates that his system can be automated.

7. Claims 17-20,25-27 and 29-36 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #5,657,805 to MAGRO. MAGRO discloses the use of a structural reinforcement system for reinforcing an opening (12) in a wall (14) of a building including a frame (16) having two vertically spaced members (22,24) and at least one horizontal member (20) connected thereto; at least one channel member (32,52,62) connected to the vertical frame members (22,24)

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and a second channel member (34,54,64) coupled to the first channel member (32,52,62) to form a groove (40) therebetween for slidably receiving at least one groove engagement device (48) disposed at the ends of at least one panel member (28) that forms the movable panel member (26) positioned in the opening (12); at least one panel restraining device (46); and a frame reinforcement (50,60) connected to the opening (12) such that the movable panel (26) provides a continuous load path when placed in a shear force transmitting position, column 2, lines 34-36 and column 5, lines 5-22. Regarding claim 18, the system of MAGRO also includes an interlocking means (L) for releasably securing the movable panels (26). In reference to claim 19, there is a second restraining device (46) disposed at and opposite end of the movable panels (26). Regarding claim 20, MAGRO, column 2, lines 4-7, indicates that his system can be automated. In reference to claim 27, the frame reinforcing device (50,60) includes an upper portion (colored red in the marked attachment) and a lower portion (colored blue in the marked attachment). Regarding claims 25,29,30,31 and 32, the upper portion (colored red) of the reinforcement device (50,60) is disposed at the side edges and within the opening (12) across the horizontal member (20) and is inherently known for reducing stress at the applied location. In reference to claims 26 and 33, the lower portion (colored blue) of the reinforcing device (50,60) is disposed lower section in the opening (12) adjacent the upper portion (colored red) of the frame reinforcement (50,60). Regarding claim 34, the reinforcing device (50,60) further includes an anchoring device (56,66). In reference to claims 35 and 36, the first and second channels are connected to the frame reinforcing device (50,60).

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*Allowable Subject Matter*

8. Claims 5-8,13-16,21-24 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (703) 308-1909.



Yvonne M. Horton

June 10, 2003



